UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/283,192	04/01/1999	YUTAKA KURABAYASHI	35.C1331	9638

5514 7590 08/19/2003

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER	
SHOSHO, CALLIE E	
ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	09/283,192	KURABAYASHI, YUTAKA	
	Examiner	Art Unit	
	Callie E. Shosho	1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☒ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *see attachment*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☐ The a)☐ affidavit, b)☐ exhibit, or c)☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *63-70 and 73-82*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' amendment filed 7/23/03 has been carefully considered. However, the amendment has not been entered given that it raises new issues that would require further consideration. The amendment raises new issues under 35 USC 112, first paragraph.

(i) The amendment adds new claim 83 which recites "wherein the ink provides an ink jet recorded image with a certain optical density that is equivalent to that produced with an ink which is the same as the aqueous ink except for containing the self-dispersing pigment as a sole colorant in the same amount as the total amount of the self-dispersing pigment and the resin encapsulating a coloring material".

It is the examiner's position that this phrase raises new issues under 35 USC 112, first paragraph because the specification, while being enabling for ink comprising self-dispersing pigment and resin encapsulating a coloring material in total amount of 8 percent by weight providing image with certain optical density that is equivalent to that produced with an ink which comprises the self-dispersing pigment as a sole colorant in the same amount, i.e. 8 percent, as the total amount of self-dispersing pigment and the resin encapsulating a coloring material, does not reasonably provide enablement for ink comprising self-dispersing pigment and resin encapsulating a coloring material in any amount providing image with certain optical density that is equivalent to that produced with an ink which comprises the self-dispersing pigment as a sole colorant in any same amount as the total amount of self-dispersing pigment and the resin encapsulating a coloring material. The specification does not enable any person skilled in the art

to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Case law holds that applicant's specification must be "commensurately enabling [regarding the scope of the claims]" *Ex Parte Kung*, 17 USPQ2d 1545, 1547 (Bd. Pat. App. Inter. 1990). Otherwise **undue experimentation** would be involved in determining how to practice and use applicant's invention. The test for undue experimentation as to whether or not all compounds within the scope of claim 83 can be used as claimed and whether claim 83 meets the test is stated in *Ex parte Forman*, 230 USPQ 546, 547 (Bd. Pat. App. Inter. 1986) and *In re Wands*, 8 USPQ2d 1400, 1404 (Fed.Cir. 1988). Upon applying this test to claim 83, it is believed that undue experimentation **would** be required because:

(a) *The quantity of experimentation necessary* is **great** since claim 83 reads on self-dispersing pigment/resin encapsulating a coloring material combination being present in any "same amount" as the self-dispersing pigment alone, i.e. 5%, 10%, 15%, etc.

(b) There is **no** *direction or guidance presented* for making ink comprising self-dispersing pigment/resin encapsulating a coloring material combination being present in any "same amount" as the self-dispersing pigment alone. The specification only discloses examples wherein the self-dispersing pigment/resin encapsulating a coloring material combination are present in total amount of 8% and the self-dispersing pigment is present alone in amount of 8%.

(c) There is an ***absence*** *of working examples* concerning making ink comprising self-dispersing pigment/resin encapsulating a coloring material combination being present in any "same amount" as the self-dispersing pigment alone.

In light of the above factors, it is seen that undue experimentation would be necessary to make and use the invention of claim 83.

(ii) Claim 82 has been amended to recite that the self-dispersing pigment and a resin encapsulating a coloring material are present in amount of "about 8 percent by weight based on the total weight of the ink". It is the examiner's position that this phrase fails to satisfy the written description requirement under 35 USC 112, second paragraph since there does not appear to be a written description requirement of the phrase "about 8 percent by weight" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163.

All the examples in the specification disclose ink wherein the self-dispersing pigment and a resin encapsulating a coloring material are present in a total amount of 8 percent by weight. Thus, while there is support in the present specification for reciting that the self-dispersing pigment and a resin encapsulating a coloring material are present in a total amount of "8 percent by weight", it is the examiner's position that there is no support for the recitation that the self-dispersing pigment and a resin encapsulating a coloring material are present in a total amount of "about 8 percent by weight". By using "about", the phrase encompasses amounts slightly above and below 8 percent, i.e. 7.8%, 8.3%, etc. for which there is no support in the present specification. The only recitation in the specification regarding the amount of self-dispersing pigment and a resin encapsulating a coloring material present in the ink discloses that the colorants are present in amount of 8 percent.

Similar arguments apply to line 10 of claim 82, which recites that the self-dispersing pigment is present as sole colorant at the solid concentration of "about 8 percent". It is the examiner's position that while there is support for the recitation that the self-dispersing pigment is present as sole colorant in amount of "8 percent", there is no support for the recitation that the self-dispersing pigment is present in a total amount of "about 8 percent".

Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
8/15/03